

REMARKS

By this Amendment, claims 19 and 27, the Abstract, and the specification are revised. Prompt and favorable action on the merits is respectfully requested.

In response to the new matter rejection, the specification and claims have been revised to reflect the original filing. Thus, the new matter rejection is now moot. Turning now to the prior art rejection, it is submitted that the prior art relied upon by the Examiner does not establish a *prima facie* case of anticipation or obviousness. The basis for this traverse is set out below under the headings of the applied prior art.

I. **CLAIMS 19 TO 30 STAND REJECTED UNDER 35 U.S.C. § 102(B) BASED ON MARSHALL**

Applicants again traverse this rejection. First, while the Examiner continues to allege that Marshall uses a dispersing dye, it is submitted that these dyes are not sublimatible coloring agents as now required by claim 19. In this regard, the Examiner's attention is directed to http://www.greatvistachemicals.com/dyes_and_pigments, wherein a dispersing dye is defined. This website shows a dispersible dye or sublimatible coloring agent that is used in dyeing of cellulose acetate in the textile industry. This dye is clearly not the same as the dyes of Marshall. Since Marshall does not teach the use of the claimed coloring agent, Marshall cannot anticipate claim 19. Moreover, there is no basis to allege obviousness despite the fact that the sublimatible coloring agent has utility in other applications. Even if the compound is known, the Examiner still must have a reason to use it in the method of Marshall. There is no reason other than hindsight for such an approach and any such rejection could not be sustained on appeal.

Applicants also reiterate the arguments made before that the method of claim 19 is not anticipated by Marshall. As the Examiner knows, anticipation requires that each and every element of the claimed method be found in Marshall. While anticipation is alleged, the Examiner implies that the process is not taught precisely by citing case law to support the contention that concurrent steps are equivalent to successive steps. The fact that case law couches this difference in terms of equivalence means that the steps are not the same and that successive steps, while acting as a basis for making an obvious rejection over concurrent steps, could not form the basis of an anticipation rejection.

The case citation regarding the concept that methods of mixing ingredients are not patentable does not support an anticipation rejection. While it may be true that one particular mixing method is not a patentable distinction for a particular composition, the issue here is the patentability of process claims not composition claims. Thus, reliance on this principal does not provide any support for the contention of anticipation.

In fact, the Examiner has not shown where each and every step of claim 19 is shown in Marshall and this failure alone means that the rejection based on 102 is improper. If the Examiner persists in making an allegation of anticipation, the Examiner is requested to identify where each step of claim 19 as well as the order of each step is found in Marshall.

In the rejection, the Examiner goes to great lengths to demonstrate that the various components used in the process or process variables such as viscosity are shown in Marshall. However, this is not the end of the inquiry since claim 19 is directed to a specific process.

In the rejection, the Examiner recites the steps of Example 1 and concludes that this reads on the reference. Clearly, this example is not the same as that set forth in claim 19 and there is no reasoning in the rejection to account for this difference; the Examiner just concludes

that the method is met. This is error on the Examiner's part since an objective basis has not been set out to support the contention of anticipation.

The rejection also lacks any reason as to how the claimed method would be obvious based on Marshall. The Examiner makes the rejection in the alternative but says nothing about the scenario where it is admitted that the method of Marshall is not the same as claim 19 but somehow could be modified so as to be the same. The failure to provide a basis to support a rejection under 35 U.S.C. § 103(a) means that no rejection has been made.

It is also submitted that Marshall does not anticipate claim 27 since Marshall does not teach a sublimatable coloring agent as is now defined in this claim. At best, Marshall can only be relied upon to reject claim 27 under 35 U.S.C. § 103(a). However, there is no legitimate reason for this approach other than hindsight and such a rejection could not be sustained on appeal.

Lastly and to the extent that the Examiner may allege that the invention is obvious, the use of the sublimatable coloring agent produces unexpected results in the realm of digital printing. As previously argued, the use of this agent produces unexpected improvements in terms of transferring ink to fabrics, see page 3, lines 13-18 and page 5, last line to page 6, line 7 of the specification. This is more than a predictable result given that these types of coloring agents were not even used for digital inks. Thus, any allegation of obviousness is effectively rebutted by the unexpected improvements associated with the invention.

Since claim 19 is patentable over Marshall, its dependent claims are also in condition for allowance.

II. JOHNSON DOES NOT ANTICIPATE OR RENDER CLAIM 27 OBVIOUS

The rejection based on Johnson is also traversed on the grounds that Johnson does not teach an ink with the claimed features, including, particularly, the sublimatible coloring agent. While the Examiner contends that dyes are not excluded from the ink of Johnson, the resolution of anticipation requires that Johnson teach the use of a sublimatible coloring agent. Clearly, this is not taught, expressly or implicitly in Johnson and therefore, the rejection based on 35 U.S.C. § 102(b) is improper. This means that the Examiner can only rely on 35 U.S.C. § 103(a) to reject claim 27.

In addressing the obviousness of claim 27 and Johnson, the Examiner must contend that it would be obvious to use another dye in Johnson's ink. While the sublimatible coloring agent is known, this alone does not mean that it is necessarily obvious to use in the method of Johnson. The Examiner must have a reason to draw such a conclusion and there is no reason to do so. The sublimatible coloring agent is used in dyeing of cellulose acetate and this does not automatically support the conclusion that it would be obvious to use in digital inks.

Even if the Examiner were to conclude that a *prima facie* case of obviousness is established, the use of the sublimatible coloring agent in the invention yields more than a predictable result. As previously argued, the use of this agent produces unexpected improvements in terms of transferring ink to fabrics, see page 3, lines 13-18 and page 5, last line to page 6, line 7 of the specification. This is more than a predictable result given that these types of coloring agents were not even used for digital inks. Thus, any allegation of obviousness is effectively rebutted by the unexpected improvements associated with the invention.

It is further argued that since Johnson teaches a different method of ink making, it cannot be assumed that the ink of Johnson has the same attributes of the ink of claim 27. In

operation, Johnson's ink is ejected from an ink jet printer and exposes to the selected radiation during its flight and cured in the absence of oxygen, see col. 7, lines 62-67 and col. 8, lines 1-10 of Johnson.

Further and in Johnson, the pigment is ground with a hyperdispersant and then a homogenous mixture is formed of the reactive diluent and oligomers, see Example 1 thereof. In contrast, the first step in making the ink of the invention is the dispersion of the sublimatible coloring agent in a mixture of oligomers and monomers and this avoids agglomeration. Given this fundamental difference in processing, Applicant asserts that the features of the ink of claim 27 are not found in Johnson and a *prima facie* case of anticipation is not established.

Moreover, there is no basis from which to modify Johnson such that it would be alleged that Johnson's modified process produces the ink of claim 27.

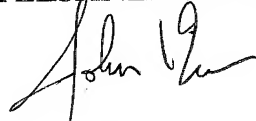
Since claim 27 has been demonstrated to be patentable over the cited prior art, their respective dependent claims are also in condition for allowance.

The rejection based on Marshall and 35 U.S.C. § 102(b) is flawed since Marshall does not teach the processing steps of claim 19 or the ink composition of claim 27. Moreover, there is no basis from which the Examiner could allege that Marshall could somehow obviate the invention of claims 19 and 27. Similarly, Johnson cannot be said to anticipate claim 27 since Johnson does not disclose all of components of the claimed ink composition. In addition, the vast difference in the processing between the invention and Johnson rebuts any contention that the Johnson ink composition can be considered to be the same as that claimed.

Accordingly, the Examiner is requested to examine this application in light of this response and pass all pending claims onto issuance.

To the extent necessary, a petition for a three month extension of time under 37 C.F.R. 1.136 is hereby made. Please charge the extension of time fee to Deposit Account 16-0607. Any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

Respectfully submitted,
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